

Docket No.: 4614-0160PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Marc DONATH

Application No.: 10/517,450

Confirmation No.: 5584

Filed: September 1, 2005

Art Unit: 1647

For: USE OF AN INTERLEUKIN 1 RECEPTOR
ANTAGONIST AND/OR
PYRROLIDINEDITHIOCARBAMATE FOR
THE TREATMENT OR PROPHYLAXIS OF
TYPE 2 DIABETES

Examiner: I. D. Dang

REQUEST/PETITION FOR REMOVAL OF "FINALITY" OF AN OFFICE ACTION

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An Office Action issued in the above-identified application on November 2, 2007 with the Examiner indicating that the action is final. Applicant submits that the finality of the Office Action is improper because the Office Action of November 2, 2007 for the first time rejects claims over prior art.

In particular, page 10 of the Office Action indicates that claims 15-17 are rejected under 35 U.S.C. §§ 103(a) over *Boone et al.* in view of *Thompson et al.* Claims 15-17 are method claims directed to treating Type II Diabetes by administration of "anakinra". Being directed to administration of an individual compound, these claims are more narrow than the generic claims which have been cancelled and were not rejected over prior art in the Office Action dated April 18, 2007. If the prior art now cited by the Examiner in the Office Action of November 2, 2007 is relevant to claims 15-17, then that same prior art would necessarily have been relevant to the

generic claims that were examined in the Office Action of April 18, 2007. But in that Office Action the Examiner specifically noted that “the prior art as made of record and not relied upon is considered pertinent to Applicants’ disclosure”, but that prior art did not include the prior art now referenced in the Office Action of November 2, 2007, and no claims were rejected over prior art in the Office Action of April 18, 2007.

It is clear, therefore, that Applicant’s amendments to the claims did not necessitate the citation of new prior art and, accordingly, it is improper for the Examiner to make the Office Action of November 2, 2007 a final Office Action. See MPEP § 706.07(a).

Applicant, therefore, requests that the finality of the Office Action be withdrawn and that a new non-final Office Action be issued.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson Reg. No. 30,330 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 3, 2007

Respectfully submitted,

By 

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